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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: CATE, et al.
APPL. NO. : 10/694,335
FILED : October 27, 2003
TITLE : METHOD AND MEANS FOR FILLING NATURAL
CASING SAUSAGES
TC/A.U. : 3643
CONFIRMATION NO. : 3859
EXAMINER : David J. PARSLEY
DOCKET NO. : P03958US2-137B
CUSTOMER NO. : 34082

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This is an appeal from the final rejection of claims 7-9 dated April 28, 2004.

I. Real Party In Interest:

The real party in interest of the instant appeal is Townsend Engineering Company, an Iowa corporation, having an address of P.O. Box 1433, 2425 Hubbell Avenue, Des Moines, Iowa 50305.

II. Related Appeals and Interferences:

There are no related appeals or interferences.

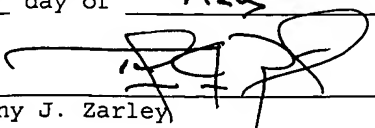
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Timothy J. Zarley

III. Status of the Claims:

Presently, claims 7-9 are pending in this application. Claims 8-9 have been rejected under 35 U.S.C. § 101, for lacking utility. Claim 7 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura (U.S. Pat. No. 4,539,796). Claims 8-9 have been rejected under 35 U.S.C. § 103(a) as being obvious in view of Nakamura and further in view of either Stiles (U.S. Pat. No. 5,372,537) or alternatively in view of Hergott (U.S. Pat. No. 6,066,035).

Claims 7-9 are hereby identified as the claims being appeals.

IV. Status of Amendments:

No amendments have been filed subsequent to the Examiner's Final Office Action of April 28, 2005.

V. Summary of Claimed Subject Matter:

The present invention is directed to a method for filling a natural hollow elongated casing 26 with a meat emulsion including providing a casing filling station 27 with a stuffing tube 16 for supporting the casing 26 to be filled with meat emulsion. See paragraph [0024] of the published application. A casing hopper 46 is provided adjacent the casing filling station 27 to serve as a reservoir for a plurality of shirred artificial casings 26 for delivery of shirred artificial casings 26 for mounting on the stuffing tube 16. See paragraph [0026]. The casing hopper 46 is moved away from its position adjacent the casing filling station 27 when natural casings 26 are placed on a stuffing tube 16 in the casing filling station 27. See paragraph [0028].

Additionally, a PLC 66 is provided and senses when the casing hopper 46 is in its position adjacent the casing filling station 27 to control longitudinal movement of the stuffing tube 16 to maintain the stuffing tube 16 in a non-automatic extension mode, to hold a follower 200 connected to the stuffing tube 16 in a retracted position, and to maintain the casing hopper 46 in its position adjacent the casing filling station 27. See paragraphs [0026] and [0028]. The natural casing 220 is placed on the stuffing tube 16 with the stuffing tube 16 being in a partially retracted position to located a discharge end of the stuffing tube 16 upstream of the casing filling station 27. See paragraph [0028]. The PLC 66 is actuated to cause the stuffing tube 16 to extend through a chuck 120, to cause a meat pump 14 to start pumping meat through the stuffing tube 16 when the position of the stuffing tube 16 through the chuck 120 is sensed, to start the rotation of the chuck 120 and the stuffing tube 16, and to start an operation of the linking chains 31 of linker 30 as well as a conveyor 44 located downstream from the casing filling station 27. See paragraphs [0026-0028]. The follower 200 is manually advanced and its arrival is sensed at a position adjacent a twister mechanism 28 containing the chuck 120, causing the PLC 66 to stop operation of the casing filling station 27. See paragraphs [0026] and [0028].

VI. Grounds of Rejection to be Reviewed on Appeal

Issue I: The rejection of claims 8-9 under 35 U.S.C. § 101 for lacking utility;

Issue II: The rejection of claim 7 under 35 U.S.C. § 102 as being anticipated by Nakamura; and

Issue III: The rejection of claims 8-9 under 35
U.S.C. § 103(a) as being obvious in view of
Nakamura in combination with either Stiles
or Hergott.

VII. Argument

Issue I: The rejection of claims 8-9 under 35
U.S.C. § 101 for lacking utility:

The Examiner has rejected claims 8-9 under 35 U.S.C. § 101 stating that the disclosed invention is inoperative and therefore lacks utility. Specifically, the Examiner reasons that "claim 8 states that a PLC is provided to sense the casing hopper and a PLC is a device that cannot be used as a sensor but instead is a device which controls a sensor and therefore the claimed invention is inoperative."

Applicant cannot agree. First, Applicant notes that claims 8-9 are method claims reciting a specific set of steps and not apparatus claims directed to the apparatus itself. Accordingly, Applicant submits that each and every piece of the related apparatus (for example, nuts and bolts) need not be recited for a method claim to have proper utility under 35 U.S.C. § 101. Here, Applicant has recited "a PLC is provided and senses when the casing hopper is in its position adjacent the casing filling station". Applicant respectfully submits that a PLC is perfectly capable of receiving information that indicates when a device is in a particular position; accordingly, as a PLC is capable of receiving position information, it is therefore "operative" to "sense" position as is recited in the claims. Accordingly, Applicant submits that claims 8-9 are fully operative and therefore provide utility under 35 U.S.C. § 101.

Issue II: The rejection of independent claim 7
under 35 U.S.C. § 102:

The Examiner has rejected independent claim 7 under 35 U.S.C. § 102(b) as being anticipated by Nakamura.

Applicant cannot agree. Specifically, Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 7 in part requires "moving the casing hopper away from its position adjacent the casing filling station when natural casings are placed on a stuffing tube in the casing filling station." According to the Examiner, Nakamura teaches

the movement of the casing hopper - at 1 is seen in Figs. 6-8, and the use of natural casings by the encasing machine is present in columns 10-11 that describe operation mode 4. The Examiner states "Figs. 6-8 show that it is inherent that the portion of the casing hopper which allows individual feeding of the casings to the stuffing position is moveable to and away from the stuffing tube and further the retraction of the stuffing tube - 3 away from the hopper - 1 after stuffing is completed allows for the hopper to be moved away from the stuffing tube and further as seen in columns 10-11 both natural and artificial casing are shown to be capable of being used in the same operation mode and therefore the hopper can contain artificial casings while a natural casing is on the stuffing tube." The Applicant respectfully disagrees.

Inherency permits, in very limited circumstances, that an invention is anticipated by prior art that is lacking minor, well-known features in the claimed invention. Evidence of inherency "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA v. Monsanto Co, 948 F.2d 1264, 20 USPQ 2s 1746, 1749-50 (Fed Cir. 1991). Inherency may not be established by probabilities or possibilities, and consequently the mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). That is, the missing element or function must necessarily result from the prior art reference. Or as the Federal Circuit has stated, "[u]nder the principals of inherency, if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim of an application, the claim is

anticipated." In re King, 801 F.2d 1324, 231 USPQ 136, 138 (Fed. Cir. 1986).

The Applicant asserts that the hopper disclosed in Nakamura does not necessarily move to perform its function. The Nakamura reference can operate with the hopper stationary and therefore does not necessarily have to function as the Applicant's device is claimed. Additionally, the Applicant asserts the hopper in Nakamura is fixed in a stationary position. As referenced above the examiner attempts to justify the finding of inherency by stating that Figs. 6-8 show the moving hopper. However, the Examiner fails to explain, or make clear how a movable hopper is necessarily present in the sausage encasing machine in the Nakamura reference as seen in Figs 6-8 and that it would be so recognized by persons of ordinary skill. Fig. 6, a plan view, and 8, a front elevational view, show the hopper 1 in the same position placed between the pump 5 and the linking device 12. Meanwhile, Fig. 7 does not show the hopper 1. Consequently, it is not inherent upon looking at Figs. 6-8 that the hopper 1 is necessarily moveable.

Additionally, within the specification there is no disclosure that the hopper moves. Rather, the only disclosure regarding the hopper is that "[t]he apparatus will continue to operate until all casings in the casing hopper 1 are stuffed with sausage dough and twisted into linked sausages and then will automatically be stopped." Col. 10, lines 21-24.

To further illustrate that there is no need for the hopper in Nakamura to move, one need only look at how the present invention and the Nakamura device are altered to receive the natural casings. In the present invention a collar 200 is slidably mounted on the stuffing tube 16 at a place underneath the hopper 46 and thus the hopper must be moved to place the collar 200 on the stuffing tube 16. See Page 8-9 and Figs. 3

and 3A. The Nakamura device produces soft natural casings in operation mode 4. See Col. 10 lines 30-33. The Nakamura device is altered by mounting the guide bar 37 to the frame F, and by coupling the arm 40 of slide sleeve 39 to the arm 41a of coupling 41. See Col. 10 lines 34-41. Then the "same procedure as that in operation mode 2" is used. Col. 10 lines 34-41. In Figs. 6-8, guide bar 37, arms 40 and 41a, coupling 41 and slide sleeve 39 are all located a distance away from the hopper 1 and not underneath the hopper 1. Consequently, the hopper 1 does not need to be moved to change the machine to accommodate natural casings. Therefore, because the only two figures that show the hopper 1, Figs. 6 and 8, present the hopper in the exact same location, because nothing in the specification discusses the movement of the hopper, and because the hopper does not need to be moved to change the encasing machine so that it is capable of filling natural casings, in contrast to the Examiner's belief, the Applicant submits that the hopper of Nakamura does not necessarily move and therefore movement is not inherent. Because the hopper 1 of Nakamura does not move as is required by claim 7, each and every element of claim 7 is not present and the Examiner's rejection cannot stand.

Issue III: The rejection of claims 8-9 under 35
 U.S.C. § 103:

Claims 8-9 stand rejected under 35 U.S.C. § 103 as being obvious in view of Nakamura and further in view of either Stiles or Hergott.

Applicant respectfully submits that dependent claims 8 and 9 are at least novel and not obvious in view of the proposed combinations due to their dependence on independent claim 7.

Additionally, dependent claim 8 recites a PLC "senses when the casing hopper is in its position adjacent the casing filling station to thereupon control ...". The Examiner contends that

Nakamura discloses a controller at 31-32 that senses when the casing hopper is in its position adjacent the casing filling station to thereupon control the longitudinal movement of the stuffing tube 3. Applicant cannot agree. Specifically, as noted above with respect to claim 7, there is not disclosure or inherent reason for Nakamura's hopper to move. Further, even were the hopper 1 of Nakamura to move, there is not teaching or suggestion in Nakamura that any movement of the control hopper be "sensed" by the PLC. The control panel 31-32 of Nakamura is disclosed "for controlling the operation of the apparatus". See column 6, lines 55-60. While the hopper 1 of Nakamura is disclosed as part of the Nakamura apparatus, there is no indication that the control panel 31-32 is directly operatively connected to the hopper 1 in any manner, let alone to "sense when the casing hopper is in its position adjacent the casing filling station" as claimed. Lastly, there is no disclosure of any "sensor" in Nakamura nor is there a disclosure of control panel 31-32 "sensing" any item of the Nakamura apparatus, let alone specifically sensing the hopper position. Accordingly, Applicant respectfully submits that dependent claim 8 is novel and not obvious in view of Nakamura.

The Examiner has combined Nakamura with Stiles or Hergott, as Nakamura does not disclose that the control is a PLC. However, Stiles and Hergott have not been cited by the Examiner to cure Nakamura of its failure to sense the casing hopper position. Stiles is not directed to an embodiment that appears to have a hopper at all, and is therefore incapable of curing Nakamura of its deficiencies cited above with respect to claim 8. Likewise, Hergott is also incapable of curing Nakamura as the PLC 36 of Hergott is not disclosed as being operatively connected to a hopper in any manner, let alone sensing the position of a casing hopper, as claimed in dependent claim 8.

Accordingly, there can be no cure of Nakamura for its failure to teach or suggest the limitation of claim 8 of the PLC "senses when the casing hopper is in its position adjacent the casing filling station to thereupon control ...".

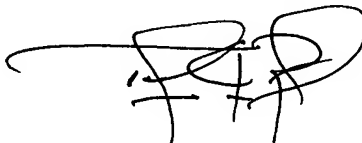
Likewise, dependent claim 9 is novel and not obvious, due at least to its dependency on dependent claim 8 and independent claim 7.

Conclusion

Accordingly, Applicant submits that claims 7-9 are in condition for allowance, and Applicant respectfully requests allowance of such claims. For all the reasons set forth above, Applicant respectfully requests the Board reverse the Examiner's Final Rejection.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "TJZ" with a large, stylized flourish extending to the left.

Timothy J. Zarley
Reg. No. 45,253
ZARLEY LAW FIRM, P.L.C
Capital Square
400 Locust Street, Suite 200
Des Moines, IA 50309-2350
Phone No. (515) 558-0200
Fax No. (515) 558-7790
Customer No. 34082
Attorneys of Record

TJZ/JJL/kc

Attachment: Appendix

APPENDIX

VIII. Claims Appendix

Claim 7. (Original) A method for filling a natural hollow elongated casing with a meat emulsion, comprising, providing a casing filling station including a stuffing tube for supporting the casing to be filled with meat emulsion, providing a casing hopper adjacent the casing filling station to serve as a reservoir for a plurality of shirred artificial casings for delivery of shirred artificial casings for mounting on the stuffing tube, and moving the casing hopper away from its position adjacent the casing filling station when natural casings are placed on a stuffing tube in the casing filling station.

Claim 8. (Previously amended) The method of claim 7 wherein a PLC is provided and senses when the casing hopper is in its position adjacent the casing filling station to thereupon control longitudinal movement of the stuffing tube, to maintain the stuffing tube in a non- automatic extension mode, to hold a follower connected to the stuffing tube in a retracted position, and to maintain the casing hopper in its position adjacent the casing filling station.

Claim 9. (Previously amended) The method of claim 8 wherein a natural casing is placed on the stuffing tube with the stuffing tube being in a partially retracted position to locate a discharge end of the stuffing tube upstream of the casing filling station; actuating the PLC to cause the

stuffing tube to extend through a chuck, and to cause a meat pump to start pumping meat through the stuffing tube when the position of the stuffing tube through the chuck is sensed, and to start rotation of the chuck and the stuffing tube, and to start an operation of linking chains and a conveyor located downstream from the casing filling station; manually advancing the follower and sensing its arrival at a position adjacent a twister mechanism containing the chuck, and causing the PLC to stop operation of the casing filling station.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None